

O-338-19

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3269748
BY THE STERLING JAMES COMPANY LLC
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 16:**

MISS TO MRS. WITH ALL MY BITCHES

AND

**OPPOSITION THERETO UNDER NO. 412961
BY MR GLEN BUCHANAN**

BACKGROUND

1. On 10 November 2017, THE STERLING JAMES COMPANY LLC (“the applicant”) applied to register the trade mark ‘MISS TO MRS. WITH ALL MY BITCHES’ for the following goods in class 16:

Banners of paper; Display banners made of cardboard; Display banners of paper; Metallic paper party decorations; Paper banners; Paper party bags; Paper party decorations; Party favor boxes of cardboard; Party ornaments of paper; Party stationery.

2. The application was accepted and published for opposition purposes on 30 March 2018.

3. Glen Buchanan (“the opponent”) opposes registration under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the first two of these grounds, the opponent relies upon the same registration, namely UK 3173545 (“the earlier mark”), which was applied for on 07 July 2016 and registered on 14 October 2016. The earlier mark is as follows:

MISS TO MRS

4. The earlier mark covers (and is relied upon for) a range of goods and services in classes 6, 9, 16, 18, 20, 21, 24, 25, 26, 28, 35.

5. The opponent claims under Section 5(2)(b) of the Act that because of the similarity between the opposed mark and the earlier mark and the similarity between the goods of the opposed mark and those of the earlier mark, there exists a likelihood of confusion. It also claims under Section 5(3) that the earlier mark has a reputation; that the opposed mark incorporates the earlier mark with the addition of offensive and distasteful words; that the similarity between the earlier mark and the opposed mark is such that the relevant public will believe that they are used by the same or related undertakings; that use of the opposed mark will cause damage to the reputation and/or identity of the earlier mark in the form of loss of sales and damage to reputation. In

particular the opponent claims that (1) the opposed mark could offend consumers and that, should consumers confuse the marks, it will damage the opponent's reputation because they will attribute any offence or negative interpretation to the opponent's business; (2) potential consumers wishing to purchase the opponent's products may mistakenly buy the applicant's products or decide not to buy the opponent's products because they are offended by the applicant's mark and they mistakenly associate the opponent with the applicant.

6. In respect of the Section 5(4)(a) claim, the opponent claims to have an earlier right in the sign 'MISS TO MRS'. It claims that it has been using the sign on *badges, stickers, balloons, t-shirts, packaging, retailing, gift bags and advertising online/social media* since March 2016 and has acquired a goodwill under the sign. Therefore, use of the trade mark applied for would be a misrepresentation to the public and result in damage to the aforementioned goodwill.

7. The applicant filed a counterstatement in which it denies the grounds of opposition. It stated:

We deny categorically any similarity of our trademark 'Mrs to Miss with all my bitches' with the opponent's trademark 'Mrs to Miss'. Our trademark was registered in December of 2016 in the U.S. From that time onwards we have been operating our business with this trademark in different parts of the world creating a unique identity and value. By the same token, during 2016 we started to commercialise to the UK with the firm intention to expand our business. Regarding the features of our trademark, we must highlight two distinctive sides of our mark from the opponent's mark. The first feature is the type and colour of our font used. Our trademark is using a single colour (black) or a combination of two colours (black and dark violet). However, in the case of the opponent, the trademark is commercialised in light violet colour or with a combination of two colours: white and light violet. Most importantly, the second distinctive feature is related with the meaning of the phrase of our trademark. It has a distinctive part of the phrase that is "with all my bitches". The combinations of the words "with all my bitches" therefore causes to the consumers a different impact and reaction regarding the trademark. The phrase 'with all my bitches' has an intrinsic link to the impact of the trademark as a whole. The trademark "Mrs to Miss with all my bitches" to the consumers is related to an amusing way to celebrate bachelor parties and also linked with a youth concept, generating a unique identity as a trademark. It is of our understanding that UKIPO regarding public policy and principles of morality has authorised our trademark. Likewise due to the phrase "with all my bitches" there is no relation with the trademark' opponent. We deny any type of damage because of the lack of similarity and connection between both trademarks. Regarding misrepresentation, there is no such misrepresentation in this case because our customers can identify our trademark due to the particular font, combination of colours and the hook-phrase "with all my bitches" of the trademark. It is clear therefore that there is no such profanity related to the opponent. Finally, we must highlight that our filing is in goodwill, and we intend to expand our trademark protection to the UK to expand and protect our business.

8. In these proceedings the opponent is not professionally represented. The applicant is represented by Avask Accounting & Business Consultants Ltd.

9. Only the opponent filed evidence. Neither side filed written submissions. Neither side requested a hearing, nor did they file submissions in lieu of attendance at a hearing. This decision is reached following careful consideration of all the papers before me.

The approach

10. This decision will focus initially upon the ground of opposition based upon Section 5(2)(b) of the Act. It is noted that the earlier trade mark is not subject to proof of use. Further, the evidence filed is predominantly concerned with the additional grounds of opposition relied upon. As such, it will not be summarised at this stage, but I will return to it later.

DECISION

11. Section 5(2)(b) of the Act reads:

“5(2) A trade mark shall not be registered if because –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. The opponent’s mark is an earlier trade mark within the meaning of Section 6(1) of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in Section 6A of the Act. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

Section 5(2)(b) - case-law

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a

composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

14. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. The applicant's goods are:

Class 16: *Banners of paper; Display banners made of cardboard; Display banners of paper; Metallic paper party decorations; Paper banners; Paper party bags; Paper party decorations; Party favor boxes of cardboard; Party ornaments of paper; Party stationery.*

20. The opponent relies on a range of goods and services in classes 6, 9, 16, 18, 20, 21, 24, 25, 26, 28, 35, however, it is only necessary to list the opponent's goods in class 16 (on which the opponent focuses):

Class 16: *Greeting cards; Gift cards; Invitation cards; Postcards; Diaries; Calendars; Organizers for stationery use; Day planners; Guest books; Stickers [stationery]; Place mats of paper; Place cards; Writing pads; Writing implements; Writing utensils; Writing stationery; Writing paper; Memo pads; Sticky tape; Adhesive labels; Adhesive note pads; Adhesive note paper; Adhesive stickers; Paper; Stationery; Envelopes; Pens; Pencil cases; Pencils; Scrapbooks; Folders; Files [stationery]; Note books; Notebooks; Note paper; Notelets; Notepads; Gift wrap; Wrapping paper; Gift bags; Gift boxes; Bags [envelopes, pouches] of paper or plastics, for packaging; Ribbons of paper; Bows (decorative-) for wrapping; Bows for decorating packaging; Gift tags; Adhesive tapes for stationery or household purposes; Tissue paper; Decorations of cardboard for foodstuffs; Decorative paper garlands for parties; Rosettes of paper; Toilet rolls; Bookmarks; Photo albums; Disposable napkins; Paper table napkins; Paper tablecloths; Paper table mats; Paper table covers; Serviettes of paper; Coasters of cardboard; Coasters made of paper; Name cards; Food wrappers; Paper bags; Bags made of plastics for packaging; Gift wraps; Label paper; Labels, not of textile; Carrier bags; Wedding books; Wedding albums; Gift vouchers; Agendas; Gift certificates; Rosettes of paper.*

21. The applicant's *Party stationery* is encompassed by the opponent's *Stationery*. On the principle outlined in *Meric*, these goods are identical.

22. The applicant's *Paper party bags* and *Party favor boxes of cardboard* are highly similar to opponent's *Gift bags* and *Gift boxes*. Though the goods have a specific purpose (i.e. the purpose of *Paper party bags* and *Party favor boxes of cardboard* is to carry small gifts given as a gesture of gratitude to guests attending parties and/or weddings; the purpose of *Gift bags* and *Gift boxes* is to carry gifts given to someone on occasions such as birthdays, Christmas, weddings, etc), they have the same nature, i.e. paper bags and boxes, target the same users, have the same methods of use, reach consumers through the same trade channels and are likely to be produced by the same undertakings.

23. The applicant's *Paper party decorations* and *Party ornaments of paper* encompass the opponent's *Decorative paper garlands for parties* which are party decorations for personal adornment or ornamentation of venues. On the principle outlined in *Meric*, these goods are identical. The applicant's *Metallic paper party decorations* are, if not identical, highly similar to the opponent's *Decorative paper garlands for parties*: the goods are all decorative party items made of paper and have a similar nature, purpose and method of use, target the same users, reach consumers through the same trade channels and are likely to be produced by the same undertakings. The same conclusion applies to the applicant's *Banners of paper and Paper banners* which include party banners. Finally, as regards the applicant's *Display banners of paper* and *Display banners made of cardboard*, the goods are unlimited and would include types of banners displaying special messages for celebrations and events, i.e. happy birthday, congratulations, etc. On that basis, for the same reasons to those outlined above, I find that these goods are highly similar to the opponent's *Decorative paper garlands for parties*.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

25. The parties’ goods in class 16 include stationery as well as gift and party accessories. The average consumer is the general public. The goods are not particularly expensive but will still be selected with an average degree of attention in order to ensure that the right item is purchased, i.e. colour, theme, etc. The goods will be selected visually from shops or websites, although I do not completely ignore aural considerations.

Distinctive character of earlier mark

26. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27. The opponent does not claim that he enjoys an enhanced degree of distinctiveness in the earlier mark. Though the opponent has provided evidence of the mark use, as I will explain below, it is on a very small scale and it does not materially improve the opponent’s position. As such, I have only the inherent position to consider.

28. The opponent’s mark consists of the words ‘MISS TO MRS’. As the case law tells me, I need to assess the distinctive character of the opponent’s mark in the context of the goods for which it is registered. Indeed, the assessment must be undertaken with a particular eye to the registered goods which are most similar to the applied for goods and represent the best-case scenario for the opponent.

29. The opponent’s evidence shows that the words ‘MISS TO MRS’ are used by the opponent in the context of party items specifically intended for hen-do celebrations, including balloons, stickers, badges, gift bags and t-shirts. It also shows that the opponent’s use features a stylised version of the words ‘MISS TO MRS’ being applied on hen-do party products in a decorative purpose. It is possible that, given the manner and the context of the opponent’s use of the earlier mark, some consumers might interpret the expression ‘MISS TO MRS’ as a decorative slogan rather than as a distinctive sign denoting the commercial origin of the goods, however, under Section 5(2)(b) the opponent is relying on a registered word mark for the plain words ‘MISS TO MRS’ covering a range of goods which are not limited to party items intended for hen-do celebrations.

30. In assessing the distinctiveness of the earlier mark I must consider notional use, rather than the opponent’s actual use, however, it is also important to consider the fact that the opponent’s goods might be used for hen-do parties, in other words, they might have a particular theme; this theme constitutes an optional (not intrinsic) characteristic of the goods which I found to be similar to the applied for goods. In this connection, I

bear in mind that (1) notional and fair use of the opponent's mark across the registered *Stationery, Gift bags, Gift boxes and Decorative paper garlands for parties* would include use on stationery, gift bags, gift boxes and decorative garlands not specifically intended for hen-do parties; (2) even where the goods are intended, i.e. themed, for hen-do parties, the distinctiveness of the mark must be assessed in the context of notional and fair use, which means not use of the words 'MISS TO MRS' solely to adorn the products, but use which is intended to indicate the undertaking of the origin of the goods, for example, the opponent has shown trade mark use of the word 'MISS TO MRS' followed by a ® symbol on various websites to designate the origin of the goods.

31. Taking all of the above into consideration and bearing in mind that the applicant has made no submissions as to the distinctiveness of the earlier mark, I consider firstly that the words 'MISS TO MRS' have an average degree of distinctive character in relation to the registered *Stationery, Gift bags, Gift boxes and Decorative paper garlands for parties*. As I have said above, the fact that the goods of the kind specified in the registration could be intended for hen-do parties is an optional aspect which some goods might possess (by displaying hen-do themes) and it does not constitute an intrinsic characteristic of the goods. Secondly, if the mark 'MISS TO MRS' were to be used in the context of items manifestly intended for hen-do parties, it would carry an allusion to the bride-to-be changing her title from Miss to Mrs, a concept which has a direct relevance to the particular theme of the goods, and it would have a below average degree of distinctiveness.

Comparison of marks

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

33. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impression created by the marks. The marks to be compared are:

MISS TO MRS v MISS TO MRS. WITH ALL MY BITCHES

34. Both marks are word marks. In its submissions, the applicant referred to the marks being different both in the fonts and colours. However, the way the parties use the marks is irrelevant and the correct approach is to conduct the comparison between the marks as they are registered and applied for. In other words, any aspects of the marks which is not reflected in their graphic representation on the register and on the application filed, must be disregarded.

35. The opponent’s mark consists of three words, namely the words ‘MISS TO MRS’ written in block capitals. It is not the case that any of the words has a greater visual prominence and the three words form a unit with its own meaning. The mark as a whole will be perceived by the relevant public as referring to an unnamed female person getting married and changing her title from Miss to Mrs. Therefore, in my view, none of the individual words dominate the opponent’s mark and the overall impression and distinctiveness of the mark rests on the unit.

36. The applied for mark consists of the words ‘MISS TO MRS’ followed by a full stop and by the words ‘WITH ALL MY BITCHES’, all written in block capitals. The mark has no element that could be considered more dominant (visually eye-catching). I acknowledge that in American-English the abbreviation ‘MRS’ uses a full stop whereas British usage favours omitting the full stop, however, I do not think that the full stop is

particularly noticeable, and it seems to me that it would be very easy to miss. In any event, even if one were to notice the full stop, it could be taken either as part of the abbreviation or as the end of the phrase 'MISS TO MRS'; in the latter case, it would reinforce the perception of the mark as being made up of two parts, i.e. 'MISS TO MRS' and 'WITH ALL MY BITCHES'. The element 'MISS TO MRS' will be seen as a unit having independent trade mark significance and referring to unnamed female person getting married and changing her title from Miss to Mrs. The preposition 'WITH' merely denotes the connection between the element 'MISS TO MRS' and the words that follows. Whilst I consider that the word 'BITCHES' is a derogatory reference to women, I agree with the applicant that the average consumer is likely to see the phrase 'WITH ALL MY BITCHES' as a slang for 'female friends' rather than a slur. This interpretation is emphasised by the significance of the words 'MISS TO MRS' and by the nature of the goods at issue, all of which can be used for parties and celebrations.

37. Visually and aurally, the respective marks are similar inasmuch as they share the word 'MISS TO MRS'. They differ (1) in the dot which is placed after the word 'MRS' and (2) in the words 'WITH ALL MY BITCHES' of the later mark which have no counterparts in the opponent's mark and make the applied for mark significantly longer. The marks are considered to be visually and aurally similar to a medium degree. Conceptually, the opponent's marks bring to mind an unnamed female person getting married and changing her title from Miss to Mrs. The same concept is conveyed by the identical words 'MISS TO MRS' at the beginning of the applied for mark. However, the applied for mark also conveys the concept introduced by the phrase 'WITH ALL MY BITCHES', whose conceptual interpretation I have discussed above, and which introduces a conceptual difference between the marks. The marks are considered to be conceptually similar also to a medium degree.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the

average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

39. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

40. I also bear in mind the decision in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

41. Earlier in this decision I concluded that:

- the respective goods are identical or highly similar;
- the average consumer is a member of the general public whose selection will be dominated by visual considerations whilst paying an average degree of attention;

- the competing marks are visually, aurally and conceptually similar to a medium degree;
- the earlier mark has an average degree of distinctiveness in relation to goods which are not specifically intended for hen-do parties and a below average degree of distinctiveness in relation to goods which are specifically intended for hen-do parties;
- in both marks the words 'MISS TO MRS' form a single identifiable unit that has its own distinct meaning compared with the meaning of the component elements taken separately. The other components of the applied for mark, i.e. the words 'WITH ALL MY BITCHES', do not alter the significance of the words 'MISS TO MRS' as a unit.

42. In terms of direct confusion, even taking into account imperfect recollection, I do not consider it likely that the average consumer, with overall impressions in mind, will mistake the applicant's mark for the opponent's as the average consumer would be likely to notice the differences between 'MISS TO MRS' and 'MISS TO MRS. WITH ALL MY BITCHES'.

43. Turning to indirect confusion, the reality of both parties' businesses, as it emerges from the applicant's submissions and the opponent's evidence, is that both parties have chosen to adopt (or incorporate in their mark) an expression, i.e. 'MISS TO MRS', which, if used in a certain manner in the context of the market segment in which the parties actually operate, namely to adorn party goods specifically intended for hen-do parties, could be interpreted by the average consumer merely as a slogan alluding to the theme of the goods rather than as a badge of origin. However, the correct approach is, as I have said, to consider notional and fair use of both marks in a way which serve to designate the provenance and trade origin of the goods concerned. I have found that in both marks the identical 'MISS TO MRS' element hangs together as a complete phrase to form a cohesive whole with a different meaning to its constituent elements. The question is whether taking into account the difference created by the words 'WITH ALL MY BITCHES' in the applied for mark, the presence of the common element 'MISS TO MRS' in both marks will lead consumers to believe that the applicant is economically connected with the opponent. I will consider two scenarios.

44. In the first scenario, I consider the instinctive reaction of the average consumer who, having encountered the earlier 'MISS TO MRS' mark on the opponent's *Stationery, Gift bags, Gift boxes and Decorative paper garlands for parties*, which are not specifically intended for hen-do parties, is then faced with the later 'MISS TO MRS. WITH ALL MY BITCHES' mark being applied on identical or highly similar goods intended for hen-do parties (this use being covered by the notional and fair use of the applied for mark). Imagine, say, that after having purchased the opponent's 'MISS TO MRS' garlands, the average consumer encounters the contested 'MISS TO MRS. WITH ALL MY BITCHES' mark on the applicant's garlands or banners intended for hen-do parties¹. In my view, in those circumstances, the average consumer whilst noticing the striking juxtaposition created by the words WITH ALL MY BITCHES (in the later mark), will contextualise these words and perceive the variation as indicating a brand extension of the earlier 'MISS TO MRS' mark, i.e. a line for products of the MISS TO MRS brand for hen-do celebrations. There is a likelihood of indirect confusion.

45. In the second scenario, the only difference is that that the earlier 'MISS TO MRS' mark has been encountered by the same average consumer on items specifically intended for hen-do parties. As I have said earlier, even if the words 'MISS TO MRS' are, in this context, less distinctive, i.e. to a below average degree, they still represent the totality of the opponent's mark and a distinctive component of the contested mark, which retains its own independent role within the contested mark. In those circumstances, I also find that the presence of the words 'MISS TO MRS' in the application will lead the consumer to believe that there is a link between the opponent and the applicant. There is a likelihood of indirect confusion.

46. The opposition under section 5(2)(b) therefore succeeds in its totality.

47. In light of this finding, any finding in respect of the grounds based upon Section 5(3) or Section 5(4)(a) will not improve the level of success already achieved by the opponent. However, in line with the guidance provided in *Trump International Ltd v*

¹ This is covered by the applicant's Paper party decorations, Metallic paper party decorations and Party ornaments of paper

DTTM Operations LLC, [2019] EWHC 769 (Ch), I will comment briefly upon the evidence and grounds based upon Section 5(3) and Section 5(4)(a) of the Act.

Section 5(3) and Section 5(4)(a)

48. For a successful opposition to be brought under these grounds the opponent must show that it had the requisite reputation and goodwill at the relevant date. As the applicant has not claimed use of the mark prior to the date of the application for registration, the relevant date for assessing whether Section 5(4)(a) applies is the filing date of the opposed mark², i.e. 10 November 2017. This is also the relevant date for the Section 5(3) claim. I do not need to summarise the evidence in great details, but it suffices to say that (1) the evidence comes from Mr Glen Buchanan, the owner of the earlier 'MISS TO MRS' mark, (2) Mr Buchanan states that the mark has been used since 2016 in relation to various goods, including greeting cards, badges, stickers, balloons, t-shirts, packaging and gift bags; (3) the use shown include use of the mark as registered, i.e. word mark, and use of a stylised version which is protected by a registered design (5002072) in a decorative manner on the goods themselves; (4) although Mr Buchanan provides some evidence about branded goods being sold on various websites including Mr Buchanan's website, joycelebrations.co.uk, amazon.co.uk and eBay.co.uk, what evidence is provided is either undated or after the relevant date and does not show any details of turnover of goods sold under the mark, nor does it provide any proof of size of the turnover in relation to the relevant market. Mr Buchanan says that he has sold 1,221 items in the period between 12 December 2017 and 12 December 2018 and 2,899 items in the preceding year, however, aside from the fact that the sale relating to the period 2017-2018 are after the relevant date, there is no breakdown by products in relation to the sales which allegedly took place in the period 2016-2017. Whilst there is some evidence of marketing activities, it is rather scant and consists essentially of (1) a few examples of the mark being advertised on Joy Celebrations' social media pages, including its twitter page; (2) an undated exhibit (GB19) from Amazon showing that 'MISS TO MRS' hen-do party balloons are rated 69 in the list of most popular items in the category of Party Balloons; various exhibits (GB21 and 24) from Amazon and eBay showing star rating

² *SWORDERS* BL O-212-06

for and feedback from customers who purchased 'MISS TO MRS' branded goods, most of which are hen-do party balloons; these are mostly dated after the relevant date but some are also dated before it, on various dates in 2017 and 2016; (3) an undated copy of a Facebook page confirming that Mr Buchanan had paid £38.96 and £30 promoting a post and a page for 'MISS TO MRS' reaching over 2,000 people and achieving 200 and 168 likes (GB27) and a receipt for £25 for a Facebook campaign covering the period between 7 and 31 December 2017, which is after the relevant date (GB26); (4) two invoices dated February 2017, one for 6,000 flyers and leaflets which are said to include the promotion of the 'MISS TO MRS' mark (it is clear from the evidence that the opponent also uses other marks but it is not clear what percentage of these 6000 costs refers to flyers and leaflets relating to the 'MISS TO MRS' mark), an another for 5,000 packaging postcards that are said were used to packing products featuring the same mark for a total of about £52 and £84 (GB28-30); (5) screenshot of a page showing that 'MISS TO MRS' Twitter activity earned 3.1K impressions in August 2018, which is after the relevant date (GB33).

49. Weighing all of the evidence as a whole, I find that it is insufficient to prove that the earlier trade mark was already known on the relevant date by a significant part of the public concerned. Hence, I also find that the opponent did not have a qualifying reputation in the UK to sustain the grounds of opposition based on Sections 5(3). The opposition under Section 5(3) fails.

50. As regards the passing off claim, the opponent's evidence has not been challenged and though it is far from overwhelming, it corroborates Mr Buchanan's account that it has been trading under the mark since at least 2016-2017. I also accept that in the period between December 2016 and December 2017 Mr Buchanan has sold 2,899 items of goods under the sign 'MISS TO MRS', most of which were hen-do party accessories, in particular balloons, and that there was some limited marketing activity. Whilst some of the use shown is use of a different mark incorporating the words 'MISS TO MRS' in a decorative manner, there are also examples of the plain words 'MISS TO MRS' being used on websites in a manner which indicate trade mark use. Accordingly, I find that that the opponent had, at the relevant date a more than trivial³

³ *Stacey v 2020 Communications* [1991] FSR 49

goodwill in the name 'MISS TO MRS'. The goodwill was on a very small scale and in the field of hen-do party balloons⁴. Whilst the similarity between the applicant's *Banners of paper; Display banners made of cardboard; Display banners of paper; Metallic paper party decorations; Paper banners; Paper party bags; Paper party decorations; Party favor boxes of cardboard; Party ornaments of paper; Party stationery*, (all of which are - or include - party accessories), and the opponent's party balloons is less pronounced, the goods target the same users, have similar purposes, are sold in the same outlets, are produced by the same undertakings and are highly complementary, so there is still a certain overlap between the respective fields of activity. On balance I find that, even considering that the level of similarity between the goods is less pronounced, i.e. medium, and the distinctiveness of the mark is lower, i.e. below average, the presence of the common element 'MISS TO MRS' in the application would be sufficient to create the requisite link, leading to misrepresentation and damage. I find that the opponent's grounds, insofar as they are based upon Section 5(4)(a), also succeeds.

COSTS

51. The opponent has been successful and is entitled to an award of costs. As the opponent is not professionally represented he was contacted at the conclusion of the evidence rounds asking him to complete a costs pro-forma if he wished to claim costs. The opponent responded to the invitation indicating that it spent a total of 6 hours dealing with the matter. The minimum level of compensation for litigants in person is £19 per hour. On that basis I award the opponent the following costs:

Official fee:	£200
Preparing the notice of opposition and considering the counterstatement:	£114
Total:	£314

⁴ Whilst there are some examples of the mark being applied to other goods, i.e. cards, stickers, badges, gift bags, they are undated and the only feedback from consumers which is dated before the relevant date is that relating to balloons.

52. I order THE STERLING JAMES COMPANY LLC to pay Mr Glen Buchanan the sum of £314. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of June 2019

Teresa Perks

For the Registrar

The Comptroller – General